

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Trademark Registration No. 3,093,389
Registered May 16, 2006

BRYAN CORPORATION,

Petitioner,

v.

NOVATECH SA,

Registrant.

Cancellation No. 92046037

TRADEMARK PROCESS
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US PATENT &
TRADEMARK OFFICE

PETITIONER BRYAN CORPORATION'S RULE 56(f) MOTION

Petitioner Bryan Corporation ("Bryan Corp."), pursuant to 37 C.F.R. § 2.127(e)(1) and Federal Rule of Civil Procedure 56(f), moves the Board to extend Bryan Corp.'s response time to Novatech S.A.'s ("Novatech's") Motion for Summary Judgment Dismissing this Cancellation Proceeding to allow Bryan Corp. to obtain needed discovery. The grounds for this motion, which are fully set forth in the accompanying Declaration of Daniel G. Jarcho, are that, because Novatech has unreasonably and in contravention of the Board's orders, refused to meaningfully respond to one of Bryan Corp.'s proper discovery requests, Bryan Corp. has not been able to fully develop the factual record with respect to Bryan Corp.'s fraud claim, on which Novatech has moved for summary judgment.

In defending against the summary judgment motion, Bryan Corp. is entitled to show that there is a genuine issue of material fact as to an element of its claim. Fraud is proven when a party is shown to have made a false statement of material fact that it knew or reasonably should have known was false. *See, e.g., Medinol Ltd. v. Neuro Vasx Inc.*, 67 U.S.P.Q.2d 1205, 1209

(T.T.A.B. 2003). Bryan Corp. alleges that Novatech committed fraud upon the United States Patent and Trademark Office ("PTO") when it declared it had the right to use STERITALC in U.S. commerce. "If fraud can be demonstrated in the procurement of a registration, the entire resulting registration is void." *Medinol Ltd.*, 67 U.S.P.Q.2d at 1208; 15 U.S.C. § 1141f(a).

As discussed in Daniel G. Jarcho's attached Declaration, Bryan Corp. has, since November 2006, sought information regarding Novatech's knowledge of its ability to use STERITALC in U.S. commerce. Specifically, Bryan Corp. requested that Novatech answer one interrogatory (Interrogatory No. 5, Second Set of Interrogatories) seeking to know whether Novatech believed at the time it declared that it had the right to use the STERITALC mark in commerce, that it had the right to sell a drug labeled STERITALC in U.S. commerce. *See* Bryan Corp.'s Nov. 30 Motion to Compel Ex. 1. Novatech, despite being ordered to provide Bryan Corp. with this information, has continually refused to meaningfully answer Bryan Corp.'s contention interrogatory.¹ *See* TTAB Sept. 28 Order. Consequently, because information directed at Novatech's state of mind is essential to Bryan Corp.'s fraud claim (intent is an element of fraud) and because such information is exclusively within Novatech's control, Bryan Corp. cannot meaningfully respond to Novatech's Motion for Summary Judgment without first receiving Novatech's adequate response to Bryan Corp.'s contention interrogatory. *See The Clorox Co. v. Armour-Dial, Inc.*, 214 U.S.P.Q. 850 (T.T.A.B. 1982); *Dunkin Donuts of America, Inc. v. Metallurgical Exoproducts Corp.*, 840 F.2d 917, U.S.P.Q.2d 1026 (Fed. Cir. 1988)

¹ As discussed fully in Bryan Corp.'s Reply to its Motion to Compel, Novatech, in response to an order by the Board compelling Novatech to respond to Bryan Corp.'s contention interrogatory, has done nothing more than recite its declaration to the PTO. A recitation of its declaration to the PTO does not answer Bryan Corp.'s question: did Novatech believe it had the right to sell a drug labeled STERITALC in U.S. commerce when it declared it had the right to use the STERITALC mark in commerce. *See* Bryan Corp.'s Reply to its Motion to Compel, Ex. 1.

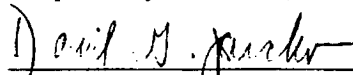
(plaintiff's Rule 56(f) discovery request allowed since evidence of defendant's intent is pertinent in a § 2 claim); *Orion Group, Inc. v. Orion Insurance Co. P.L.C.*, 12 U.S.P.Q.2d 1923, 1924-25 (T.T.A.B. 1989) (Rule 56(f) discovery request allowed since facts relating to defendant's use of mark were in defendant's control). Therefore, Bryan Corp. requests that the Board extend the time for Bryan Corp. to respond to Novatech's motion and further order Novatech to meaningfully respond to Bryan Corp.'s contention interrogatory on the issue of Novatech's knowledge of its ability to use STERITALC in U.S. commerce.

CONCLUSION

Based upon the foregoing, the Board should grant Bryan Corp. its requested Rule 56(f) relief by (1) extending Bryan Corp.'s time to respond to Novatech's Motion for Summary Judgment and (2) ordering Novatech to meaningfully respond to Bryan Corp.'s contention interrogatory on the issue of Novatech's knowledge of its ability to use STERITALC in U.S. commerce.

Dated: December 21, 2007

Respectfully submitted,



Daniel G. Jarcho, Esq.

Andrew J. Park, Esq.

Kristin H. Landis, Esq.

MCKENNA LONG & ALDRIDGE, LLP

1900 K St. NW

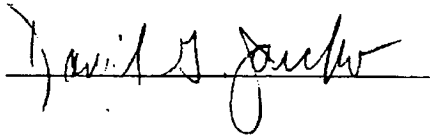
Washington, DC 20006

Attorneys for Petitioner Bryan Corporation

CERTIFICATE OF SERVICE

I hereby certify that on this 21st day of December, 2007, a copy of the foregoing Rule 56(f) Motion and Declaration of Daniel G. Jarcho were served, by first class mail, postage prepaid, upon:

John S. Egbert, Esq.
Egbert Law Offices
State National Building
412 Main Street
7th Floor
Houston, TX 77002

A handwritten signature in black ink, appearing to read "Daniel G. Jarcho", is written over a horizontal line.

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BRYAN CORPORATION,)	
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Petitioner,)	
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)	
NOVATECH SA,)	
)	
Registrant.)	
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DECLARATION OF DANIEL G. JARCHO

I, Daniel G. Jarcho, declare as follows:

1. I am counsel of record for Petitioner Bryan Corporation ("Bryan Corp.") and have been engaged in that role since Summer 2006. I have participated in all aspects of this cancellation proceeding and am knowledgeable regarding both the facts of the petition and the legal requirements required to prove the allegations in the petition.

2. On July 11, 2006, Bryan Corp. filed a petition seeking cancellation of Registrant Novatech S.A.'s ("Novatech's") trademark STERITALC, registered on May 16, 2006, on among other grounds, that Novatech committed fraud upon the United States Patent and Trademark Office when Novatech declared that it believed it was entitled to use the STERITALC mark in commerce.

3. For Novatech to succeed on Summary Judgment with regard to Bryan Corp.'s fraud claim, it must show that there is no genuine issue of material fact as to its state of mind

when it filed a declaration stating that it believed it was entitled to use the mark STERITALC in commerce.

4. On November 10, 2006, in an effort to discover Novatech's state of mind at the time of filing the declaration, Bryan Corp. served Novatech with a contention interrogatory (Interrogatory No. 5, Bryan Corp.'s Second Set of Interrogatories) seeking to know whether, at the time Novatech declared it believed it had the right to use the STERITALC mark in commerce, Novatech believed it had the right to sell a drug that bears the name STERITALC in U.S. commerce.

5. Novatech refused to answer Bryan Corp.'s contention interrogatory, thus prompting Bryan Corp. to file a motion to compel Novatech's response. Bryan Corp. filed its motion to compel on March 7, 2007.

6. On September 28, 2007, the Board granted Bryan Corp.'s motion to compel with respect to the contention interrogatory and ordered Novatech to supply Bryan Corp. with the information it seeks.

7. Novatech alleges that it served Bryan Corp. with supplemental interrogatory responses on November 5, 2007. Bryan Corp., however, did not receive the responses, and Bryan Corp. filed another motion to compel on November 30, 2007.

8. At approximately 5:00 p.m. EST on November 30, Bryan Corp. received via email Novatech's supplemental interrogatory responses.

9. Novatech's supplemental response to Bryan Corp.'s contention interrogatory states that "[t]he Declaration meant that Registrant 'believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form

thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive.”

10. Novatech’s supplemental response simply recites the language from its declaration filed with its registration. It does not provide Bryan Corp. with an answer to its question as to Novatech’s underlying state of mind when it filed the declaration.

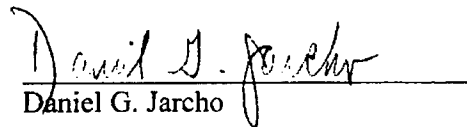
11. Novatech’s knowledge regarding its ability or inability to sell the drug labeled STERITALC in commerce is an element of Bryan Corp.’s fraud claim.

12. Novatech’s state of mind at the time of filing is solely within the control of Novatech.

13. Without the requested information Bryan Corp. cannot adequately respond to Novatech’s claim that there is no genuine issue of material fact regarding fraud.

14. Based upon the foregoing, Bryan Corp. requests that, pursuant to Rule 56(f) of the Federal Rules of Civil Procedure and 37 C.F.R. § 2.127(e)(1), the Board extend Bryan Corp.’s response time to allow Bryan Corp. to obtain a meaningful response to its contention interrogatory. Further, Bryan Corp. requests that the Board again order Novatech to meaningfully respond to Bryan Corp.’s contention interrogatory.

The undersigned being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements and the like may jeopardize the validity of the application or document or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true; and all statements made on information and belief are believed to be true.


Daniel G. Jarcho

BRYAN CAVE

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February 12, 2008

Via Express Mail

Assistant Commissioner of Trademarks
Post-Registration Division
P.O. Box 1451
Alexandria, VA 22313-1451

Mark:	MAC'S
Registration No.:	2,585,835
Registrant:	Alimentation Couche-Tard, Inc.
Issued:	June 25, 2002

Chicago
Hong Kong
Irvine
Jefferson City
Kansas City
Kuwait
Los Angeles
New York
Phoenix
Shanghai
St. Louis
Washington, DC

*And Bryan Cave,
A Multinational Partnership,
London*

Dear Assistant Commissioner:

Enclosed for filing with the U.S. Patent and Trademark Office is a Voluntary
Surrender of Registration for the mark MAC'S, U.S. Registration No. 2,585,835.

Thank you very much.

Very truly yours,

Elizabeth Goldberg
Elizabeth Goldberg

Enclosures



02-13-2008